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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,223	10/20/2005	Iain F McVey	MEDZ 2 01324 US	9349
27885	7590	03/09/2009		
Fay Sharpe LLP 1228 Euclid Avenue, 5th Floor The Halle Building Cleveland, OH 44115			EXAMINER BERNS, DANIEL J	
			ART UNIT	PAPER NUMBER
			1793	
			MAIL DATE	DELIVERY MODE
			03/09/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/554,223	<b>Applicant(s)</b> MCVEY ET AL.	
	<b>Examiner</b> DANIEL BERNS	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 54-104 is/are pending in the application.
- 4a) Of the above claim(s) 81-90 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 54-80 and 91-104 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/15/09</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 81-90 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. *Applicant's 1/15/09 request that claims 81-90 be rejoined, should claim 54 be found allowable, is denied.* Claims 81-90, while currently drafted as depending from claim 54 (a method claim) as per 1/15/09 amendment to claim 81, nevertheless remain as apparatus claims, properly restricted as detailed in Examiner's 8/21/08 and 12/5/08 communications. While it is true that method of manufacture and method of use claims may be fit for rejoinder if a related product claim were found allowable, *see* MPEP 821.04, the same is not true for apparatus claims if a method of using claim is found allowable.

In addition, claims 81-90 improperly remain marked as "(Currently Amended)." They should be marked as "(Withdrawn Amended)," "(Currently Amended – Withdrawn)," or the like.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). *See, e.g., In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re*

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*Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 54-80 and 91-104 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Pat. No. 7,102,052 to McVey et al. ("the '052 patent"). Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim common subject matter and the '052 patent's claims do not exclude the instant claimed subject matter.

4. Claims 54-80 and 91-104 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-34 of copending Application No. 10/422,474 (the current claim version as submitted in applicant's 11/9/07 Appeal Brief) ("the '474 application"). Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim common subject matter and the '474 application's claims do not exclude the instant claimed subject matter. This is a provisional

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obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Arguments***

5. Applicant's arguments, filed 1/15/09 with respect to Grebinski, US 4,867,799 (1989) have been fully considered and are persuasive. The rejection of claims 91-93, 96, and 98-103 under 35 U.S.C. 103(a) over Grebinski have been withdrawn.

***Allowable Subject Matter***

6. Claims 54-80 and 91-104 are allowable as written over the prior art and do not suffer from any deficiencies under 35 U.S.C. § 112. The following is an examiner's statement of reasons for indicating allowable subject matter: Grebinski appears to be the most pertinent reference of record. Grebinski, as discussed in the 12/5/08 Office Action, discloses the use of  $\text{H}_2\text{O}_2$  and  $\text{NH}_3$  (both gaseous) to treat various objects. However, as Grebinski's  $\text{H}_2\text{O}_2$  :  $\text{NH}_3$  ratio is 1:5, it is clear that Grebinski's main ingredient is  $\text{NH}_3$ , and that  $\text{H}_2\text{O}_2$  is but an additive in the prior art process. The  $\text{H}_2\text{O}_2$  :  $\text{NH}_3$  ratio in independent claim 54 clearly indicates that  $\text{H}_2\text{O}_2$  is the main ingredient in the claimed process, and that  $\text{NH}_3$  is but an additive therein. Further, independent claims 91, 92, 94 and 96 are also patentable over Grebinski, as Grebinski fails to teach or suggest the applicability of its methodology to decontaminating items contaminated with agent GD (reducing said GD to <1% of its initial concentration in <6 hrs.) by contacting said items with a vaporous mixture of a peroxide and ammonia as in claim 91; deactivating a pathogenic chemical agent by reducing said agent's concentration to <1% of its initial concentration via contact with pH-increased, peroxide-containing vapor mixture as in claim 92; deactivating a pathogenic chemical agent by reducing said agent's concentration to <1% of its

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initial concentration via contact with a ~200-800 ppm H<sub>2</sub>O<sub>2</sub> and 3-40 ppm NH<sub>3</sub> vapor mixture as in claim 94; and deactivating a biologically active substance by contacting it with a gaseous mixture of a strong oxidant and an alkaline compound comprising a mist of atomized alkaline liquid as in claim 96. Specifically, Grebinski's photoresist-cleaning method, which likely was employed with phenolic Novolak<sup>TM</sup> resins of the day, would be inapplicable to the applicant's deactivation of biologically active agents such as GD, VX, and the like- these agents do not contain any aromatic groups therein and are thus not likely hydrolyzed or otherwise chemically altered by Grebinski's phenolic photoresist-directed methodology.

Nevertheless, the double-patenting rejections above must be overcome or otherwise obviated before the claims can be deemed fully allowable and a Notice of Allowability prepared.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL BERNS whose telephone number is (571)270-5839. The examiner can normally be reached on Monday thru Thursday, 9AM-6PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached at (571)272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. B./ March 5, 2009

Examiner, Art Unit 1793

/Stuart Hendrickson/

Primary Examiner, Art Unit 1793